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HW

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/884,531 | 06/19/2001 | Brian McConnell | 310/1-25587-039 | 2612 |
| 36614 | 7590 | 01/23/2006 | | |
| MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304 | | | EXAMINER | |
| | | | BHATIA, AJAY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2145 | |

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/884,531 | MCCONNELL ET AL. | |
| | Examiner | Art Unit | |
| | Ajay M. Bhatia | 2145 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Response to Arguments

Applicant has elected group II, after examiner made a restriction requirement on October 4, 2005.

In response to applicants arguments presented for the restriction:

Applicant in amendments presented July 7, 2005 added the new limitation "user of the portable electronic device, the message identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to a transmission of the email message thereto" applicant makes these amendments to claims in Group II but not to Group I. Additionally Group I is presented toward receiving a e-mail message, parsing the message, and sending a reply message. Group II is directed towards a phone call (**a different communication medium**), authenticating the user of the portable electronic device and recording a voice message. Therefore the examiner is not persuaded, the restriction is proper, therefore the restriction is maintained.

In light of the restriction examiner will only address claims and arguments directed toward the elected claims. Group II (Claims 6-10)

Due to applicant amendment to independent claims 6 and 10 of Group II, examiner had provided new grounds of rejection addressing the new limitations, therefore making current arguments moot.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 and 10 recites the limitation "prior to a transmission of the email message" in step c. There is insufficient antecedent basis for this limitation in the claim. The claims does not discuss a message being sent or indicium, therefore it is unclear how indicium is assigned to an email message by the user prior to transmission of the email.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ron et al. (US Patent 6,775,359 referred to as Ron) in view of Okada et al. (US Patent 6,463,134 referred to as Okada).

For claim 6, Ron teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of: (Ron, Col. 4 lines 57-67)

(a) receiving a call in an email server from the user of the portable electronic device; (Ron, Col. 4 lines 51-67)

(c) obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device; (Ron, Col. 6 lines 24-34)

(d) authenticating the message-identifying indicium; (Ron, Col. 6 lines 24-34)

(e) requesting the user of the portable electronic device to record a voice message; (Ron, Col. 4 lines 57-67)

(f) recording the voice message; and (Ron, Col. 4 lines 57-67)

(g) transmitting the voice message to the user of the office-based terminal. (Ron, Col. 4 lines 51-67)

Ron does not specifically disclose, (b) determining if the user of the portable electronic device is registered as a user of the email server; user of the portable electronic device, the message-identifying indicium having been assigned to an email message received

by the user of the portable electronic device prior to a transmission of the email message thereto;

Okada in the same field of endeavor, email/voice systems, teaches, (b) determining if the user of the portable electronic device is registered as a user of the email server; (Okada, Col. 13 lines 1-8) user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to a transmission of the email message thereto; (Okada, Col. 13 lines 21-39, mail ID)

Ron is compatible with Okada, because Ron allows for "a parameter associated with a specific the incoming message" and Okada provides for a mail ID that is provided by the gateway, which is contained in the message.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ron containing voice data in email message with Okada provides an easy message response system, which make use of the internet to respond to voice messages using email and more convenient to him. (Okada Col. 8 line 56-60) and (col. 1 lines 50-60, Col. 3 lines 5-19)

For claim 7, Ron-Okada teaches, further comprising the step of converting the recorded voice message into a format adapted for attachment to an electronic message. (Ron, Col. 4 lines 51-67)

For claim 9, Ron-Okada teaches, further comprising the step of determining if the recorded message is acceptable and if not, recording the message again. (Ron, Col. 5 line 60 to Col. 5 line 8)

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ron et al. (US Patent 6,775,359 referred to as Ron) in view of Okada et al. (US Patent 6,463,134 referred to as Okada).

For claim 8, Ron-Okada does not specifically disclose, further comprising the steps of playing an error message and terminating the program if the user of the portable electronic device is not registered as a user of the email server.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make to include a security system with that of Ron-Okada to prevent from inappropriate users to access another's information, play an error message to the and terminating the program, similar to other security system for other electronic system in the same field of endeavor. (for example windows login, answering machines, voice mail system)

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister et al. (U.S. Patent 6,442,242) in view of Ron et al. (US Patent 6,775,359 referred to as Ron) in further view of Okada et al. (US Patent 6,463,134 referred to as Okada).

For claim 10, McAllister teaches, (g) converting the recorded voice message into MP-3 format; (McAllister col. 8 line 30)

McAllister does not specifically disclose,
a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:
(a) receiving a call in an email server from the user of the portable electronic device;
(b) determining if the user of the portable electronic device is registered as a user of the email server;
(c) obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device;
(d) authenticating the message-identifying indicium;
(e) requesting the user of the portable electronic device to record a voice message;
(f) recording the voice message;
(h) transmitting the voice message to the user of the office-based terminal.

Ron, in the same field of endeavor, of voice messages, teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of: (Ron Col. 4 lines 57-67)

- (a) receiving a call in an email server from the user of the portable electronic device; (Ron Col. 4 lines 57-67)
- (b) determining if the user of the portable electronic device is registered as a user of the email server; (Ron Col. 6 lines 24-34)
- (c) obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device; (Ron Col. 6 lines 24-34)
- (d) authenticating the message-identifying indicium; (Ron Col. 6 lines 24-34)
- (e) requesting the user of the portable electronic device to record a voice message; (Ron Col. 4 lines 57-67)
- (f) recording the voice message; and (Ron Col. 4 lines 57-67)
- (h) transmitting the voice message to the user of the office-based terminal. (Ron Col. 5 lines 5 to Col. 6 line 8)

McAllister is compatible with Ron because both system attach voice message to email message. (Ron Col. 6 line 10) and (McAllister abstract)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of McAllister with the method of Ron because they are providing ways of improving the retrieval and response to message when away from the home or

office workstation. (Ron, Col. 2 lines 40-55) and (See McAllister, Col. 1 lines 22-33, Col. 2 lines 16-26)

Ron-McAllister does not specifically disclose,

(c) obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device; user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to a transmission of the email message thereto;

Okada in the same field of endeavor, email/voice systems, teaches,

(b) determining if the user of the portable electronic device is registered as a user of the email server; (Okada, Col. 13 lines 1-8)

(c) obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device; user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to a transmission of the email message thereto; (Okada, Col. 13 lines 21-39, mail ID)

Ron-McAllister is compatible with Okada, because Ron allows for "a parameter associated with a specific the incoming message" and Okada provides for a mail ID that is provided by the gateway, which is contained in the message.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ron- McAllister containing voice data in email message with Okada provides an easy message response system, which make use of the internet to respond to voice messages using email and more convenient to him. (Okada Col. 8 line 56-60) and (col. 1 lines 50-60, Col. 3 lines 5-19)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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